

REMARKS

A non-final Office Action was mailed September 13, 2006. In the Office Action, claims 1-9, 21-25, 32-39, 44 and 45 were rejected, and claims 46-52 were withdrawn as being directed to a non-elected invention. Claims 10-20, 26-31, and 40-43 were objected to as depending from a rejected base claim. Claims 46-52 have been cancelled in this response without prejudice to pursuit in a continuing application, and claims 53-56 have been added. Reconsideration of the present application as amended and including claims 1-45 and 53-56 in view of the remarks that follow is respectfully requested.

Claims 1, 3, 21, 32, 33, and 44 were rejected as being anticipated under 35 USC §102(e) by U.S. Patent No. 6,569,169 to De La Barrera et al. De La Barrera discloses an instrument with pivoting gripping elements 21, 22 having teeth on the ends thereof that bite into the spinous process when engaged to the spinous process. The instrument also includes a central gripping element 23 with teeth that bite into the end of the spinous process when gripping elements 21, 22 are engaged to the sides of the spinous processes. These teeth prevent the gripping elements 21, 22 from being released from the spinous process except by moving the gripping elements away from one another and away from the longitudinal axis. See Figs. 6-7 and accompanying disclosure at col. 6, line 6-39. This engagement relationship provides a secure gripping of the spinous process and prevents the instrument from moving relative to the spinous process so that the instrument can be employed to indicate a position of the spinous process with indicator 40.

Claim 1, in contrast, recites an arrangement where "said distal arm portions further being movable proximally relative to said holder with said actuator assembly upon manipulation of said handle assembly to release the implant from between said distal arm portions while said holder maintains contact with the implant." Gripping elements 21, 22 are not movable proximally relative to gripping element 23 to release the spinous process when the gripping element 23 is engaged to the spinous process. De La Barrera only discloses an arrangement where gripping elements 21, 22 are rotatable about their respective pivotal coupling location with the instrument. Furthermore, the teeth of gripping elements 21, 22 would prevent gripping elements 21, 22 from moving proximally relative to gripping portion 23 to release the spinous process from between gripping elements 21, 22 when gripping portion 23 is engaged to the spinous process. Accordingly, De La Barrera fails to disclose the elements arranged as recited in

claim 1, and withdrawal of the rejection of claim 1 and claim 3 depending from claim 1 is respectfully requested.

With respect to claim 21, it recites, among other features, "an implant engaging portion at a distal end of the instrument, said implant engaging portion including a holder positionable in contact with the implant and said pair of distal arm portions adjacent said holder, said distal arm portions being movable relative to one another to engage the implant therebetween with said holder in contact with the implant, wherein said holder and said distal arm portions are each offset to a first side of the longitudinal axis." De La Barrera discloses an arrangement where gripping portions 21, 22 are offset to opposite sides of longitudinal axis 33, and gripping portion 23, asserted to be the holder in the Office Action, is centered on longitudinal axis 33 so that it contacts the upper side of the spinous process when the gripping elements 21, 22 are moved toward the spinous process to engage it on opposite sides. See Figs. 6 and 7, and col. 6, lines 6-39. De La Barrera thus fails to disclose an arrangement where gripping elements 21, 22 and 23 are each offset to a first side of longitudinal axis 33. Therefore, claim 21 distinguishes De La Barrera and is allowable.

As discussed above, the Office Action indicates that gripping element 23 is a holder and that pivotal gripping elements 21, 22 are arm portions. De La Barrera et al. discloses an instrument where the gripping element 23 is movable axially in a constrained manner as a result of gripping elements 21, 22 approaching spinous process 39 along a curved path. As a result of this pivoting of gripping elements 21, 22 toward the longitudinal axis, gripping element 23 moves axially and distally toward the spinous process and also moves toward gripping elements 21, 22 when the teeth of gripping elements 21, 22 bite into the spinous process. See col. 6, lines 40-51. To release the spinous process and move the gripping elements 21, 22 away from gripping element 23, gripping elements 21, 22 are pivoted so to move away from the longitudinal axis while also moving away from gripping element 23. Accordingly, De La Barrera et al. fails to disclose an instrument with "said actuator assembly being manipulatable with said handle assembly to simultaneously translate said distal arm portions away from said holder and toward said longitudinal axis" as recited in amended claim 32. Therefore, claim 32 distinguishes De La Barrera et al. and withdrawal of this rejection is respectfully requested.

Claim 44 has been amended and recites "means for coupling said handle assembly with said implant engaging portion, said means being operable with said handle assembly to translate said pair of distal arm portions proximally and transversely to the longitudinal axis wherein distal ends of said arms portions are located proximally of said holder." De La Barrera et al. fails to disclose any arrangement or means to translate the gripping elements 21, 22 so that the distal ends thereof are located proximally of gripping element 23. Accordingly, claim 44 distinguishes De La Barrera et al. and withdrawal of this basis of the rejection is respectfully requested.

Claims 2, 4-7, 22-25, 34-36 and 45 were rejected under 35 USC §103(a) as being unpatentable over De La Barrera et al. in view of U.S. Patent No. 6,599,294 to Fuss et al. Claims 2 and 4-7 depend directly or indirectly from claim 1, claims 22-25 depend directly or indirectly from claim 21, claims 34-36 depend directly or indirectly from claim 32, and claim 45 depends from claim 44. The claims are allowable at least because the claims 1, 21, 32 and 44 from which each depends is patentable for the reasons provided above. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

Claims 8, 9 and 37-39 were rejected under 35 USC §103(a) as being unpatentable over De La Barrera et al. in view of U.S. Patent No. 6,126,674 to Janzen. Claims 8, 9 and 37-39 depend directly or indirectly from claims 1 and 32, respectively. Claims 8-9 and 37-39 are allowable at least because the claims 1 and 32 from which each depends is patentable for the reasons provided above. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

New claims 53-56 have been added. Claim 53 present original claim 40 in independent form, and is believed allowable as indicated in the Office Action. Claims 54-56 depend from claim 52 and correspond to claims 41-43 and are allowable along with claim 53.

Reconsideration of the present application as amended and including claims 1-45 and 53-56 is respectfully requested. A Notice of Allowance is hereby solicited. The Examiner is welcome to contact the undersigned to facilitate examination of the present application.

Respectfully submitted,

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